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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/785,647

02/24/2004

David S. Benco

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EXAMINER

PATEL, HEMANT SHANTILAL

ART UNIT

PAPER NUMBER

2614

MAIL DATE

DELIVERY MODE

07/17/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/785,647	<b>Applicant(s)</b> BENCO ET AL.	
	<b>Examiner</b> HEMANT PATEL	<b>Art Unit</b> 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 7-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's submission filed on May 14, 2009 in response to Office Action dated November 14, 2008 has been entered. Claims 1-4, 7-18 are pending in this application.

### ***Response to Amendment***

2. Applicant's arguments with respect to claims 1-4, 7-18 have been considered but are moot in view of the new ground(s) of rejection. The rejections are necessitated due to claim amendments.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ye (US Patent No. 7,171,190 B2), and further in view of Collins (US Patent No. 6,424,828 B1).

**Regarding claim 9**, Ye teaches of a method wherein short message service (SMS) messages with destination cellular telephone number are received, analyzed and routed according to destination address i.e. SMS messages to cellular telephone number and email or IM messages to user email address or username (col. 3 ll. 4-13, ll. 28-35; col. 4 ll. 21-26; col. 5 ll. 8-15) and message is formatted (processed) if the sender and receiver message capabilities are not compatible (col. 6 ll. 5-27), and these receiving, analyzing and formatting are processed within the network element (Fig. 1 item 102, col. 3 ll. 36-44, col. 6 ll. 48-col. 7 ll. 15), and sending as an IM message to the recipient (col. 5 ll. 6-15) (col. 2 ll. 58-col. 7 ll. 60).

Ye does not specifically teach of determining destination data of the message to be telephone number in SMS message to decide transmission through a gateway for the data network.

However, in the same field of communication, Collins teaches of a protocol converter in a network element (Fig. 2A item 240, Fig. 3 item 330, Fig. 5 item 730, Fig. 8 item 930) analyzing the recipient SMS address field to determine if it is internet address or another cellular telephone and processing the message through the internet e-mail gateway if the destination is not the cellular telephone, and processing the message through mobile service provider if the destination is another cellular phone i.e. not the e-mail address (col. 5 ll. 29-col. 6 ll. 11).

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It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ye to check the destination address field in the received message to process it through internet e-mail gateway if the destination is not the cellular phone, and process the message through mobile service provider if the destination is another cellular phone i.e. not the e-mail address as taught by Collins in order to allow communication between users using two disparate devices in two different systems i.e. cellular phone user using SMS in wireless network and internet station user using e-mail (Collins, col. 4 ll. 43-col. 6 ll. 18) i.e. to allow "the user of the cellular telephone to send a communication to the Internet station where the SMS address of the Internet station is not available to the user of the cellular telephone" (Collins, col. 9 ll. 4-7), and processing the message to make it compatible to the recipient capability so that "devices of different communication types may communicate using message delivery system" (Ye, col. 6 ll. 13-14) and "An SMS message specifying that an email be sent to user #2 may be used" (Ye, col. 7 ll. 30-31).

**Regarding claim 10,** Ye teaches of sending incoming message in its original format based on the destination and its communication type if no conversion is required and this conversion determination is based on destination address i.e. SMS transmission through wireless for cellular phone (col. 3 ll. 3-13; col. 4 ll. 21-26; col. 5 ll. 8-15; col. 6 ll. 24-31).

6. Claims 1-4, 7-8, 11-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ye (US Patent No. 7,171,190 B2), and further in view of Collins (US

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Patent No. 6,424,828 B1), and further in view of Bernstein (US Patent Application Publication No. 2004/0128356 A1).

**Regarding claim 1**, Ye teaches of a system wherein the instant messaging (IM) messages and short message service (SMS) messages are routed according to destination address i.e. SMS messages to cellular telephone number and email or IM messages to user email address or username (col. 3 ll. 6-13, ll. 28-35; col. 4 ll. 21-26; col. 5 ll. 8-15) and message is formatted (processed) if the sender and receiver message capabilities are not compatible (col. 6 ll. 5-27) by a message formatter included within the network element (Fig. 1 item 102, col. 3 ll. 36-44, col. 7 ll. 5-15). Ye teaches of parsing incoming MMS, SMS, Instant messaging and email messages for the destination address and processing the message when sending and receiving devices are incompatible and these devices are determined by the destination addresses used in the message (col. 3 ll. 4-12; col. 6 ll. 48-col. 7 ll. 15) (col. 2 ll. 58-col. 7 ll. 60).

Ye does not specifically teach of determining destination data of the message to be telephone number in SMS message or e-mail address in IM message to decide the transmission of the message either through a gateway for the data network or a gateway for the wireless network.

However, in the same field of communication, Collins teaches of a protocol converter in a network element (Fig. 2A item 240, Fig. 3 item 330, Fig. 5 item 730, Fig. 8 item 930) analyzing the recipient SMS address field to determine if it is internet address or another cellular telephone and processing the message through the internet e-mail

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gateway if the destination is not the cellular telephone, and processing the message through mobile service provider if the destination is another cellular phone i.e. not the e-mail address (col. 5 ll. 29-col. 6 ll. 11).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ye to check the destination address field in the received message to process it through internet e-mail gateway if the destination is not the cellular phone, and process the message through mobile service provider if the destination is another cellular phone i.e. not the e-mail address as taught by Collins in order to allow communication between users using two disparate devices in two different systems i.e. cellular phone user using SMS in wireless network and internet station user using e-mail (Collins, col. 4 ll. 43-col. 6 ll. 18) i.e. to allow "the user of the cellular telephone to send a communication to the Internet station where the SMS address of the Internet station is not available to the user of the cellular telephone" (Collins, col. 9 ll. 4-7), and processing the message to make it compatible to the recipient capability so that "devices of different communication types may communicate using message delivery system" (Ye, col. 6 ll. 13-14) and "An SMS message specifying that an email be sent to user #2 may be used" (Ye, col. 7 ll. 30-31).

Ye and Collins do not teach of IM messages with destination email address.

However, in the same field of communication, Bernstein teaches of using recipient email address with IM messages for Instant messaging session (Paragraphs 0014-0024, 0118-0137).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ye and Collins to include IM messages with recipient email address for Instant messaging session as taught by Bernstein in order to allow “parties to use their email address as their “screen name”” since “valid email addresses are guaranteed to be universally unique names” (Paragraph 0014) and “users may choose to permanently save Instant Messaging sessions in much the same way that they save email” (Paragraph 0019).

**Regarding claim 2,** Ye teaches of a message switching element (Fig. 1 item 102, switches messages from sender to the receiver). Collins teaches of message switching element (Fig. 2A item 230).

**Regarding claim 3,** Collins teaches of a mobile switching center (col. 4 ll. 43-59).

**Regarding claim 4,** Ye teaches of a message router (Fig. 1 item 102; routes messages from sending device to the recipient device). Collins teaches of a message router (Fig. 2A items 235, 240).

**Regarding claims 7, 8,** Ye teaches of sending incoming message in its original format based on the destination and its communication type if no conversion is required and this conversion determination is based on destination address i.e. SMS transmission through wireless for cellular phone and IM transmission to user computer (data network) for username (col. 3 ll. 3-13; col. 4 ll. 21-26; col. 5 ll. 8-15; col. 6 ll. 24-31). Collins teaches of sending incoming message in its original format based on the



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destination and its communication type if no conversion is required and this conversion determination is based on destination address (col. 5 ll. 29-42).

**Regarding claim 11**, Ye teaches of a method wherein instant messaging (IM) messages with destination username are received, analyzed and routed according to destination address i.e. SMS messages to cellular telephone number and email or IM messages to user email address or username (col. 3 ll. 4-13, ll. 28-35; col. 4 ll. 21-26; col. 5 ll. 6-15) and message is formatted (processed) if the sender and receiver message capabilities are not compatible (col. 6 ll. 5-27, col. 6 ll. 48-col. 7 ll. 15), and these receiving, analyzing and formatting are processed within the network element (Fig. 1 item 102, col. 3 ll. 36-44, col. 7 ll. 5-15) (col. 2 ll. 58-col. 7 ll. 60).

Ye does not specifically teach of determining destination data of the message to be email address in IM message to decide transmission through a gateway for the data network.

However, in the same field of communication, Collins teaches of a protocol converter in a network element (Fig. 2A item 240, Fig. 3 item 330, Fig. 5 item 730, Fig. 8 item 930) analyzing the recipient address field to determine if it is internet address or another cellular telephone and processing the message through the internet e-mail gateway if the destination is not the cellular telephone, and processing the message through mobile service provider if the destination is another cellular phone i.e. not the e-mail address (col. 5 ll. 29-col. 6 ll. 11).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ye to check the destination address field in the received

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message to process it through internet e-mail gateway if the destination is not the cellular phone, and process the message through mobile service provider if the destination is another cellular phone i.e. not the e-mail address as taught by Collins in order to allow communication between users using two disparate devices in two different systems i.e. cellular phone user using SMS in wireless network and internet station user using e-mail (Collins, col. 4 ll. 43-col. 6 ll. 18) i.e. to allow "the user of the cellular telephone to send a communication to the Internet station where the SMS address of the Internet station is not available to the user of the cellular telephone" (Collins, col. 9 ll. 4-7), and processing the message to make it compatible to the recipient capability so that "devices of different communication types may communicate using message delivery system" (Ye, col. 6 ll. 13-14) and "An SMS message specifying that an email be sent to user #2 may be used" (Ye, col. 7 ll. 30-31).

Ye and Collins do not teach of IM messages with destination email address.

However, in the same field of communication, Bernstein teaches of using recipient email address with IM messages for Instant messaging session (Paragraphs 0014-0024, 0118-0137).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Ye and Collins to include IM messages with recipient email address for Instant messaging session as taught by Bernstein in order to allow "parties to use their email address as their "screen name"" since "valid email addresses are guaranteed to be universally unique names" (Paragraph 0014) and "users may

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choose to permanently save Instant Messaging sessions in much the same way that they save email” (Paragraph 0019).

***Regarding claim 12,*** refer to rejections for claim 11 and claim 8.

***Regarding claim 13,*** it recites a system, with means functions to receive and process SMS message if the destination in the SMS message is not the telephone number, substantially similar to the system as claimed in claim 1. Ye teaches of such a system with means (Fig. 1 items 10-40, 102; Fig. 3 items 302-310). Collins teaches of such a system with means (Figs. 2A, 3, 5, 8). Bernstein teaches a system (Fig. 1). Refer to rejections for claim 1.

***Regarding claim 14,*** refer to rejections for claim 13 and claim 7.

***Regarding claim 15,*** it recites a system, with means functions to receive and process IM message if the destination in the IM message is not an e-mail address, substantially similar to the system as claimed in claim 1. Ye teaches of such a system with means (Fig. 1 items 10-40, 102; Fig. 3 items 302-310). Collins teaches of such a system with means (Figs. 2A, 3, 5, 8). Bernstein teaches a system (Fig. 1). Refer to rejection for claim 1.

***Regarding claim 16,*** refer to rejections for claim 11 and claim 8.

***Regarding claims 17, 18,*** Ye teaches of multiple services provided by the network element and these services require subscription (col. 3 ll. 1-44). It would be obvious to check whether the user has subscribed to a particular service before providing that service as was well known in the art. Collins teaches of user receiving SMS service from Bellsouth mobile service provider requiring service subscription for

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services as was well known in the art (col. 4 ll. 43-59, col. 10 ll. 65-col. 11 ll. 25 services managed by the service provider). It would be obvious for Bellsouth to check for subscription of service by the user before providing the service.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent Application Publication No. 2002/0007398

Mendiola

US Patent No. 6,484,196

Maurille

US Patent No. 7,058,036

Yu

US Patent Application Publication No. 2007/0010265

Henderson

US Patent No. 7,319,882

Mendiola

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEMANT PATEL whose telephone number is (571)272-8620. The examiner can normally be reached on 8:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Hemant Patel  
Examiner  
Art Unit 2614

/Hemant Patel/  
Examiner, Art Unit 2614